

### **REMARKS**

This is in response to the Office Action mailed on September 8, 2004, and the references cited therewith.

No claims are amended, claims 16-18 are canceled, and claims 19-20 are added; as a result, claims 1-15 and 19 - 20 are now pending in this application.

### **Affirmation of Election**

Restriction to one of the following claims was required:

Group I – claims 1-15

Group II – claims 16-18

As provisionally elected by Applicants representative, Peter Maki , on September 2, 2004, Applicant elects to prosecute the invention of Group I, claims 1-15.

The claims of the non-elected invention, claims 16-18, are hereby canceled. However, Applicant reserves the right to later file continuations or divisions having claims directed to the non-elected inventions.

### **§103 Rejection of the Claims**

Claims 1-15 were rejected under 35 USC § 103(a) as being unpatentable over Blair et al. (U.S. 5,462,505) in view of Downey (U.S. 612,895).

#### **Claims 1-8**

Applicant traverses the rejection of claim 1-8 since there is no suggestion to combine the references as suggested. Moreover, even if combined, the combination does not include each limitation of the claims.

The reference (or references when combined) must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Claim 1 recites “a surface of the open weave section includes an image printed directly on the surface.” In contrast, the Downey reference discusses image C being printed upon sizing B, which covers a textile fabric A. There is no image printed directly on the surface of textile fabric A. Accordingly, even if combined, the combination of references does not include “a

surface of the open weave section includes an image printed directly on the surface”, as recited in the claim.

Moreover, a factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). Here, Downey discusses a waterproof advertising sign having textile fabric A, sizing B, lettering C, and a paraffin covering D. Downey appears to be a non-see-through sign. The sign of Downey would not be suitable for the walls of an inflatable device since one cannot see through it. Thus, one skilled in the art would be discouraged from combining Downey with an inflatable device. Combining them would make an unsafe or undesirable bouncer where people desire to see in and out.

Furthermore, the combination is improper since the Downey reference is in a non-analogous field. Analogous art is all art that is either in the field of technology of the claimed invention or deals with the same problem solved by the claimed invention even though outside the field of technology. *In re Wood*, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979).

Again, Downey is in the field of advertising signs and deals with the problem of providing a waterproof sign. In contrast, claim 1 recites an inflatable comprising an inflatable portion having an inlet couplable to a blower to blow air into an interior of the inflatable portion; and an open weave section coupled to the inflatable portion and defining a wall or a window of the inflatable, wherein a surface of the open weave section includes an image printed directly on the surface.

Thus, Downey is not analogous art because it is clearly in a different field and it is not concerned with the problems solved by the present claimed invention. For example, the claimed invention provides an inflatable device having an image printed directly on the surface of an open weave section. By printing the image directly on the surface of the open weave, an image can be provided while still allowing the user to see through the wall. This is not the problem solved by the Downey reference. Nor is it a concept taught in the art by any of the cited references.

Claims 2-8 include each limitation of their parent claim and are therefore also not obvious in view of the cited references. Moreover, regarding claims 6-8, Applicant traverses the assertions of the Office Action that the limitations recited in those claims are a matter of design choice. Since all the elements of the claim are not found in the cited references, Applicant assumes that the Examiner is taking Official Notice of the missing elements. Applicant respectfully objects to the taking of Official Notice and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully requests that the Examiner cite references in support of this position. Reconsideration and allowance is respectfully requested.

*Claims 9-14*

Claim 9 includes a similar limitation as claim 1, reciting “the open weave section having an image digitally printed on a surface of the open weave section.” Again, Applicant believes neither reference, singly or in combination, discloses such subject matter. And moreover, there is no motivation in the art to provide an image digitally printed on a surface of an open weave section of an inflatable. The above discussion is incorporated herein by reference.

Claim 10-14 include all the limitations of their parent claim and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

ROBERT FIELD ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 359-3267

Date 12/7/04

By Peter C. Maki

Peter C. Maki  
Reg. No. 42,832

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 7 day of December, 2004.

Name

KACIA LEE

Signature

Kacia Lee